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Louis M. Heidelberger
Reed Smith LLP
2500 One Liberty Place
Philadelphia, PA 19103-7301

EXAMINER

NASH, LASHANYA RENEE

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,671

Applicant(s)

CHERN, VINCENT

Examiner

LaShanya R Nash

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 2-10, 12, 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1- 26 are pending.

Priority

Claim to provisional application 60/279439 has been made in this application. The effective filing date for the subject matter defined in the pending claims in the application is March 29, 2001.

Examiner suggests including the aforementioned provisional application number in the Cross Reference to Related Patent Application section of the specification (page 1, paragraph [0001]).

Claim Objections

Claims 2-10, 12, and 17 are objected to because of the following informality: insufficient antecedent basis.

Claims 2-10, 12, and 17 recite the limitation "the step" in line 2 [claims 2-8, 10, and 12], and line 1 [claim 9]. This limitation lacks proper antecedent basis. Examiner suggests amending the claims to recite the limitation "a step" for proper correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 11 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the step of reconnecting" in line 1. In addition, associated dependent claim 1 fails to recite a limitation regarding disconnecting or terminating a connection from the first server. It is unclear how a reconnection can be made without a prior disconnection; therefore the scope of the claim is rendered indeterminate. Examiner suggests amending claim 11 to recite the limitations, "a step of disconnecting from the first server...and reconnecting to the first server ..." for proper correction.

Claim 19 recites the limitation "input/output means". This claim can be interpreted in several contradictory ways, and subsequently is determined to be indefinite. For purposes of the following art rejections, the limitation of the aforementioned claim is interpreted as, "input means and output means" in view of the applicant's specification (page 11, paragraph [0044]).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by

Qua et al. (US Patent 6,222,909), hereinafter referred to as Qua.

In reference to claim 1, Qua explicitly discloses a method for employing an audio note taking mechanism. The disclosed mechanism enables a user of a wireless device to store audio files (i.e. audio notes) and subsequently distribute them to other recipients over a wireless network via email (column 1, lines 40-49; Figure 1; and Figure 3). Qua discloses:

- A method for sending an audio file to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, (column 1, lines 40-49; column 2, lines 49-59) comprising:
 - Communicatively connecting to a first server (i.e. email server) over the wireless communications network, (column 2, line 49 to column 3, line 7 and Figure 1);
 - Selecting an option to send the audio file to the email recipient, (column 5, lines 46-52 and column 3, lines 59-66);
 - Communicatively connecting to a second server (i.e. adjunct server for audio note taking mechanism) over the wireless communications network, (column 3, lines 8-12 and column 4, lines 12-22);
 - Recording the audio file on the second server, (column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43); and
 - Sending the audio file to the email recipient, (column 5, lines 52-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,4-6,8-10,13-14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua as applied to claim 1 above, and further in view of Gupte et al. (US Patent Application Publication 2001/0034225) hereinafter referred to as Gupte.

In reference to claim 18, Qua discloses a method for sending a voice message (i.e. audio note) to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, (column 1, lines 40-49; column 2, lines 49-59) comprising: selecting an option to send a voice message (i.e. audio note) to the email recipient, (column 5, lines 46-52 and column 3, lines 59-66); recording the voice message on an interactive voice response server (i.e. adjunct server for audio note taking mechanism), (column 3, lines 8-12 and column 4, lines 11-22); recording the voice message on an interactive voice response server, (column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43; column 6, lines 32-35; and column 6, line 64 to

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column 7, line 19); and sending the voice message in an attachment to an email to the email recipient, (column 5, lines 52-62).

However, Qua does not disclose expressly dialing a phone number for communicatively connecting to an email server in a data packet connection over the wireless communication network. Nonetheless, one of ordinary skill in the art at the time of the art would have readily recognized the advantages to implementing this modification to the audio note taking method, as further evidenced by Gupte.

In an analogous art, Gupte explicitly discloses a method for providing email messages, including audio file attachments, to a wireless communications device, (paragraph [0014], lines 1-16; paragraph [0016], lines 1-6). This method involves the user of a wireless device dialing a phone number to connect to an email server (i.e. email server system) (paragraph [0018], lines 1-11). Gupte further discloses establishing a data packet connection between the wireless device and the email server, for subsequent access to an email message (paragraph [0022], lines 1-23). This modification would have been obvious because one of ordinary skill in the art would have been motivated to extend the functionality of the audio note taking method to provide automatic access to the email server system with only a single dialing action by the user (Gupte paragraph [0017], lines 8-12).

In reference to claim 2, Qua discloses communicatively connecting to a first server (i.e. email server) (column 2, line 49 to column 3, line 7 and Figure 1), but fails to disclose expressly: dialing a phone number for connecting to the first

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server using the wireless communication device; and establishing a data packet connection between the wireless communication device and the first server.

Nonetheless, this would have been an obvious modification to the audio note taking method, disclosed by Qua, for one of ordinary skill in the art at the time of the invention.

Gupte discloses, dialing a phone number for connecting to the first server (i.e. email server system) using the wireless communication device, (Gupte paragraph [0018], lines 1-11 and Figure 1); and establishing a data packet connection (i.e. data channel) between the wireless communication device and the first server, (Gupte paragraph [0022], lines 1-8 and Figures 1-2) in order to provide email access to wireless devices. One of ordinary skill in the art would have been motivated to implement this modification so as to provide easy access to selected emails or other electronic communications via a wireless device (Gupte paragraph [0006], lines 6-10).

In reference to claim 4, Qua and Gupte show the audio note taking method wherein the step of selecting an option to send the audio file further comprises: viewing a received email file on the wireless communication device, (Gupte paragraph [0005], lines 6-11); selecting an option to respond to the received email file, (Gupte paragraph [0031], lines 6-9); and selecting an option for attaching the audio file to the response to the received email file, (Gupte paragraph [0031], lines 9-11).

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In reference to claim 5, Qua and Gupte show the audio note taking method wherein the step of communicatively connecting to a second server (i.e. adjunct server for audio note taking mechanism) further comprises: transmitting a signal to the second server indicating a pending connection with the wireless communication device, (Qua column 3, lines 8-13 and column 3, lines 22-26) ; terminating the connection with the first server, (Gupte [0023], lines 1 –5); and establishing an audio connection between the wireless communication device and the second server, (Qua column 4, lines 11-22 and column 6, lines 32-36).

In reference to claim 6, Qua and Gupte show the audio note taking method wherein the step of transmitting a signal to the second server (i.e. adjunct server for audio note taking mechanism) further comprises sending user identification information (i.e. identification code) to the second server, (Qua column 6, lines 32-36).

In reference to claim 8, Qua and Gupte show the audio note taking method wherein the step of recording the audio file further comprises: providing an audio input through the wireless communication device, (Qua column 3, lines 22-26); and storing the audio input as an audio file on the second server (i.e. adjunct server for audio note taking mechanism, (Qua column 4, lines 40-43).

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In reference to claim 9, Qua and Gupte show the audio note taking method further comprises providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file, canceling the recording, and sending the audio file to the email recipient, (Qua column 3, lines 59-66 and column 6, line 64 to column 7, line 19).

In reference to claim 10, Qua and Gupte show the audio note taking method wherein the step of sending the audio file to the email recipient further comprises: transmitting a signal (i.e. audio file) to the first server (i.e. email server) indicating that the audio file is ready to be sent; attaching the audio file to an electronic mail file; and sending the electronic mail file to the email recipient, (Qua column 5, lines 46-64 and Figure 3).

In reference to claim 13, Qua and Gupte show the audio note taking method wherein the first server (i.e. email server system) comprises an email server, (Gupte paragraph [0016], lines 1-13 and Figure 1).

In reference to claim 14, Qua and Gupte show the audio note taking method wherein the second server (i.e. adjunct server for audio note taking mechanism) comprises an interactive voice response server, ((column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43; column 6, lines 32-35; and column 6, line 64 to column 7, line 19).

In reference to claim 16, Qua and Gupte show the audio note taking method wherein the audio file comprises a .wav file, (Gupte paragraph [0016], lines 4-6 and paragraph [0031], lines 6-12).

In reference to claim 17, Qua and Gupte show the audio note taking method wherein the step of sending the audio file to the email recipient comprises the step of sending a hyperlink (i.e. pointer or URL) to the audio file stored on the second server (i.e. adjunct server for audio note taking mechanism), (Gupte paragraph [0033], lines 7-13 and Qua column 3, lines 59-66).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Oakes et al. (US Patent 6,205,342), hereinafter referred to as Oakes.

In reference to claim 3, Qua and Gupte teach the audio note taking method wherein the step of selecting an option to send the audio file further comprises the step of selecting an option for attaching the audio file an email file, (Qua column 5, lines 46-52 and column 3, lines 59-66). However the references fail to teach expressly selecting an option for composing a new email file. Nonetheless, this limitation was well known in the art at the time of the invention, as further evidenced by Oakes. Therefore, one of ordinary skill in the art would have readily recognized the advantages to implementing this modification.

In an analogous art, Oakes teaches a user of a wireless device (i.e.

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cellular phone) entering a message creation mode in order to compose an initial email file (i.e. text message), (column 3, line 63 to column 4, line 12 and Figure 4).

One of ordinary skill in the art would have been so motivated to accordingly modify the audio note method so as to increase the ease of generating email files (i.e. text message) for wireless device users, thereby increasing convenience (Oakes column 1, lines 6-10).

Claims 7, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Gibson et al. (US Patent Application Publication 2002/0016174), hereinafter referred to as Gibson.

In reference to claim 7, Qua and Gupte disclose the audio note taking method that comprises disconnecting from the first server (i.e. email server system) (Gupte paragraph [0023], lines 1-5). However, the references fail to disclose storing a set of state information on the wireless communication device, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to the same state in the first server that existed prior to the step of terminating the connection. Nonetheless, one of ordinary skill in the art would have readily recognized the advantages associated with implementing this modification to the audio note taking method, as further evidenced by Gibson.

In an analogous art, Gibson discloses a method involving web-enabled wireless devices switching between an Internet connection and telephone connection at the request of the user, (paragraph [0053], lines 1-10 and Figure 5). Gibson further discloses interruption processing that saves state information (i.e. base address) of the original connection on the wireless device in order to re-establishes communication to the associated entity, (paragraph [0053], lines 11-21). The aforementioned modification would have been obvious because one of ordinary skill in the art would have been motivated to provide a mechanism for switching back and forth between voice communication and data communication to users of wireless devices, thereby increasing convenience (Gibson paragraph [0035], lines 1-5).

In reference to claim 11, Qua and Gupte teach the audio note taking method comprises disconnecting from the first server (i.e. email server system) (Gupte paragraph [0023], lines 1-5). However, the references fail to teach expressly reconnecting to the first server (i.e. email server system). Nonetheless, one of ordinary skill in the art would have readily recognized the advantages associated with this modification to the audio note taking method, as further evidenced by Gibson.

In an analogous art, Gibson teaches a method involving web-enabled wireless devices reconnecting access to voice communication and data communication such as the Internet, in order to directly access web content by using a telephone number format (paragraph [0014], lines 1-11; paragraph

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[0035], lines 1-5, and paragraph [0023], lines 1-7). This modification would have been obvious because one of ordinary skill in the art would have been motivated to provide an efficient mechanism for selecting between voice and data modes to users of wireless devices (i.e. wireless phones), (Gibson paragraph [0035], lines 1-5).

In reference to claim 12 Qua, Gupte, and Gibson show the audio note taking method wherein the step of reconnecting to the first server comprises: providing the user with a plurality of options selected from the group consisting of: listening to a second audio file stored on the second server, and reconnecting to the first server (i.e. email server system), (Qua column 7, lines 1-17; column 6, lines 32-35; Gibson paragraph [0036], lines 5-17; and Figure 3).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Segur (US Patent 6,212,550), hereinafter referred to as Segur.

In reference to claim 15, Qua and Gupte show the audio note taking method involving connecting to a first server (i.e. email server system) and a second server (i.e. adjunct server for audio note taking mechanism). However, the references do not show a method wherein the first and second servers are connected by common platform means. Nonetheless, this modification would have been obvious to one of ordinary skill in the art at the time of the invention, as further evidenced by Segur.

Segur discloses a multi-format communications client-server that subsequently combines audio file storage and email distribution on a common platform, (column 1, lines 58-65; column 2, lines 27-55, and Figure 2). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note taking method so as to access one centralized server, thereby decreasing time associated with accessing multiple message sources (Segur column 1, lines 58-65 and column 1, lines 24-27).

Claims 19-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view of Gillig et al. (US Patent 5,127,042) hereinafter referred to as Gillig.

In reference to claim 19, Qua and Gupte show an audio note taking system that enables a user of a wireless device to sending a voice message (i.e. audio note) to an e-mail recipient, (Qua column 1, lines 40-49 and Figure 1). The references show the aforementioned system to comprise: a wireless communications network capable of supporting audio and data transmission, the wireless communications network comprising at least one base station, at least one base station controller (i.e. router), at least one mobile switching center (i.e. switch), (Qua column 2, lines 49-63 and Figure 1); a wireless communication device in communication with the wireless communications network through the at least one base station, the wireless communication device comprising, (Qua column 2, lines 49-53): a receiver for receiving email text, (Gupte paragraph

[0004], lines 1-11); a display for displaying the email text to a user of the wireless communication device, (Gupte paragraph [00005], lines 6-11); converting means for converting the voice message to a digitally stored audio file, the converting means (i.e. adjunct server for audio note taking mechanism) in communication with the wireless communication device over the wireless communications network, (Qua column 5, lines 46-60 and Figure 1) ; and mailing means (i.e. email server) for sending the audio file to the email recipient, the mailing means in communication with the wireless communication device over the wireless communications network, (column 5, lines 60-62 and Figure 1).

However the references fail to show expressly the wireless device comprising an audio input means and an output means for receiving audio input and delivering audio output. Nonetheless, this limitation was well known in the art at the time of the invention, as evidenced by Gillig. Therefore, this modification to the wireless device of the disclosed audio note taking system would have been obvious to one of ordinary skill in the art at the time of the invention.

In an analogous art, Gillig shows a wireless device (i.e. cellular cordless phone) that comprises an audio input means (i.e. microphone) and an audio output means (i.e. speaker) for receiving audio input and delivering audio output in order to place cellular telephone calls, (column 1, lines 36-40; column 2, lines 56-62; and Figure 2). This modification would have been obvious because one of ordinary skill in the art would have been motivated to support increased mobility of the wireless devices used to access the audio note taking system, (Gupte paragraph [0003], lines 6-10).

In reference to claim 20, Qua, Gupte, and Gillig show the audio note taking system wherein the wireless communication device is a wireless phone, (Gupte paragraph [0004], lines 1-3; paragraph [0015], lines 1-6; and Figure 1).

In reference to claim 21, Qua, Gupte, and Gillig show the audio note taking system wherein: the converting means is an interactive voice response server, (Qua column 2, lines 5-8; column 5, lines 46-50; column 3, lines 8-21; and Figure 1); and the mailing means is an email server, (Qua column 5, lines 60-62 and Figure 1).

In reference to claim 22, Qua, Gupte, and Gillig show the audio note taking system wherein the wireless communication device is adapted to call the mailing means (i.e. email server system) and present identification information to the mailing means, (Gupte paragraph [0018], lines 1-4; paragraph [0030], lines 1-4; and Figure 1).

In reference to claim 23, Qua, Gupte, and Gillig show the audio note taking system wherein the digitally stored audio file comprises a .wav file, (Qua column 7, lines 28-30 and Gupte paragraph [0031], lines 6-12).

In reference to claim 25, Qua, Gupte, and Gillig show the audio note taking system wherein wireless handset (i.e. cell phone) is further adapted to

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present information to the user by means of a wireless markup language, (Gupte paragraph [0017], lines 5-8; paragraph [0024], lines 5-7; and Figure 3). It is inherent that a wireless markup language is supported within use of the Wireless Application Protocol (WAP) browser.

Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte, and Gillig as applied to the claims above, and further in view of Uppaluru (US Patent 5,915,001), hereinafter referred to as Uppaluru.

In reference to claim 24, Qua, Gupte, and Gillig show the audio note taking system to further comprise a digitally stored audio file (Qua column 7, lines 28-30). However, the references do not show explicitly that audio file comprising a streaming audio file. Nonetheless, this limitation was well known in the art at the time of the invention, as further evidenced by Uppaluru. Thusly, this modification to the system would have been obvious to one of ordinary skill in the art at the time of the invention.

In an analogous art, Uppaluru shows a system that presents a pre-recorded voice file through an audio stream (i.e. voice stream) to provide access to voice based documents via the Internet, specifically utilizing links and embedded URLs (column 2, lines 22-41 and column 8, lines 11-25). One of ordinary skill in the art would have been motivated to implement this modification so as to support access to voice and speech files for user-customization and speaker dependent voice recognition in IVR systems (i.e. audio note taking system), (Uppaluru column 2, lines 13-20).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua, Gupte, and Gillig as applied to the claims above, and further in view of Segur.

In reference to claim 26, Qua, Gupte, and Gillig teach the audio note taking system comprising a mailing means (i.e. email server) and a converting means (i.e. adjunct server for audio note taking mechanism). However, the references do not show a system wherein mailing means and the converting means are connected by common platform means. Nonetheless, this modification would have been obvious to one of ordinary skill in the art at the time of the invention, as further evidenced by Segur.


Segur discloses a multi-format communications client-server that subsequently combines a converting means (i.e. voice synthesizer and voice recognition processor) and a mailing means (i.e. communication interface) to a common platform in order to store and transmit messages (column 1, lines 58-65; column 2, lines 45-67, and Figures 2-3). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note taking system to employ a centralized server for storage and delivery of messages in a plurality of communication formats, thereby increasing system efficiency (Segur column 1, lines 58-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (703) 305-8910. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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